

## REMARKS

In view of the following comments, and pursuant to 37 C. F. R. § 1.111, Applicant respectfully requests reconsideration of the Advisory Action mailed July 30, 2007.

### Summary

Claims 1-2, 4, 8, 12-16, 18, and 19 have been rejected under 35 U.S.C. § 102(b) as being anticipated in view of Bartman *et al.* (U.S. Pat. No. 4,891,053). Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* in view of Angenent *et al.* (U.S. Pat. No. 4,895,585). Claims 6, 7, and 9-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* in view of Nied *et al.* (U.S. Pat. No. 5,290,333).

Claim 1 has been amended to include the subject matter of claim 10 and to remove additional subject matter introduced in the Response mailed July 11, 2007. Accordingly, claim 10 has been canceled. No new subject matter has been introduced as a result of these amendments.

### Claim 1: New Matter Rejection

The Advisory Action mailed July 30, 2007 states that the previous amendment of wherein the “projected portion” of the optical element is “wholly contained by the void part” could not be supported by the original specification as filed. Accordingly, Applicant has withdrawn the amendment of “wholly contained.” However, the Applicant respectfully maintains that the “projected portion” is “contained by the void part.”

### Claims 1-2, 4, 8, 12-16, 18, and 19: Rejections under 35 U.S.C. § 102(b)

Claims 1-2, 4, 8, 12-16, 18, and 19 have been rejected under 35 U.S.C. § 102(b) as being anticipated in view of Bartman *et al.* Applicant respectfully traverses these rejections, and submits that claim 1 is patentable over Bartman *et al.* As claim 1 is patentable, the claims that depend therefrom are also patentable.

Claim 1 is generally directed to a method for making a holder/optical-element assembly. Amended claim 1 now recites the subject matter of claim 10 and has been amended to further clarify Applicant's invention. Amended claim 1 recites that the cylindrical holder material has "an outer circumferential surface and an inner circumferential surface, wherein the inner circumferential surface has a void part," and that "the projected portion" is "contained by the void part and between the inner circumferential surface and the outer circumferential surface." Support for these amendments can be found in original claim 10 and in the specification as filed, particularly at ¶¶5-15 and ¶¶26-28. Amended claim 1 is patentable over Bartman *et al.* because Bartman *et al.* does not teach or suggest these features.

In contrast with the recitations of amended claim 1, Bartman *et al.* specifically discloses that the purpose of the "annular gap" is to allow an "excess quantity of glass" to flow away from the "biconvex lens":

An excess quantity of glass is pressed from the hotter central part of the lens blank into the annular gap. The annular gap between the two rings can be determined so that with a given viscosity the associated pressure can be obtained. By means of the gap, a high pressure can be realized in the glass during the moulding process. If the volume is now still further reduced, glass **will flow out of the gap** under the influence of the pressure generated by the dies. The two rings act as a damper; due to the counterpressure, the two dies are braked so that time is gained to accomplish the moulding process. (emphasis added). Bartman *et al.*, cols. 1-2, ll. 66-9.

Bartman *et al.* also discloses that during the molding process, the excess quantity of glass is pressed through the annular gap and forms a "collar" on the outer portion of the lens element:

At this stage, the convex surfaces must be solidified by heat transfer to the dies, while at the centre the glass must remain sufficiently viscous to be pressed through the gap. The moulding time is the time duration of this stage, in practice about 1 second. FIG. 6 shows the moulded lens element 21 obtained in this way. **The excess quantity of glass pressed away through the annular gap 9 forms a collar 25 on the lens element.** (emphasis added). *Id.* at col. 5, ll. 61-68.

Hence, the structure of the biconvex lens holder cannot contain the excess quantity of glass, but rather, permits the excess quantity of glass to flow beyond the confines of the biconvex lens holder. The process of forming the collar on the lens element is also illustrated in Figures 6-7.

Accordingly, Bartman *et al.* does not teach or suggest all of the features recited by amended claim 1. Amended claim 1 recites that the projected portion is contained “between the inner circumferential surface and the outer circumferential surface.” This feature is sufficiently described throughout Applicant’s original application and is detailed in Figures 1, 4, and 6. In contrast, the function and structure of the annular gap shown in Bartman *et al.* cannot contain an excess quantity of glass and permits it to flow beyond the surfaces and confines of the biconvex lens holder. Thus, not only does Bartman *et al.* fail to teach or suggest the features recited in amend claim 1, but Bartman *et al.* teaches away from the features.

As Bartman *et al.* does not disclose each and every feature of claim 1, but in fact, teaches away from these features, Applicant respectfully submits that amended claim 1 is patentable over Bartman *et al.* As claim 1 is patentable over Bartman *et al.*, claims 2, 4, 8, 12-16, 18, and 19 are also patentable for at least this same reason. Accordingly, Applicant respectfully requests withdrawal of these rejections.

**Claims 3, 6, 7, 9, 11, and 17: Rejections under 35 U.S.C. § 103(a)**

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* in view of Angenent *et al.* This rejection is overcome for at least the same reason as discussed with reference to claim 1. Furthermore, the addition of Angenent *et al.* does not overcome the deficiencies in Bartman *et al.*

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* This rejection is overcome for at least the same reason as discussed with reference to claim 1.

Claims 6, 7, 9, and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartman *et al.* in view of Nied *et al.* These rejections are overcome for at least the same reason as discussed with reference to claim 1. Furthermore, the addition of Nied *et al.* does not overcome the deficiencies in Bartman *et al.*

Accordingly, Applicant respectfully requests withdrawal of the rejections against claims 3, 6, 7, 9, 11, and 17.

## **Conclusion**

Therefore, in view of the above amendment and remarks, Applicant respectfully submit that this application is in condition for allowance and such action is earnestly requested.

If for any reason the Examiner is not able to allow the application, he is requested to contact the Applicant's undersigned attorney at (312) 321-4200.

Respectfully submitted,

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